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OFFICE OF PETITIONS

GOODWIN PROCTER LLP
ATTN: PATENT ADMINISTRATOR
620 Eighth Avenue
NEW YORK NY 10018

In re Moe et al. : DECISION ON REQUEST
Patent No. 7,588,212 : FOR
Issue Date: September 15, 2009: RECONSIDERATION OF
Application No. 10/615,673 : PATENT TERM ADJUSTMENT
Filed: July 8, 2003 : and
Atty Docket No. 104874-142119 : NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision on the REPLY TO DECISION ON REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH, filed on May 17, 2010. Patentees assert the April 20, 2010 dismissal of patentees' Request for Recalculation of Patent Term Adjustment in View of Wyeth, filed on March 19, 2010 (certificate of mailing date March 15, 2010) was in error and request recalculation of the patent term adjustment indicated on the patent.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED**.

The Request for Recalculation of Patent Term Adjustment in View of Wyeth, filed on March 19, 2010, was filed within 180 days of the September 15, 2009 date of issuance of the patent because it was filed utilizing certificate of mailing practice. The certificate of mailing affixed to the transmittal letter for the correspondence lists March 15, 2010 as the date of deposit. Under 37 CFR 1.8, the request for recalculation is considered to have been filed on March 15, 2010. The 180 day deadline to file the request for recalculation fell on a Sunday, March 14, 2010. March 15, 2010 was the first business day after the deadline. Therefore, the request for recalculation was timely filed and should not have been dismissed.

The B delay period is 179 days. The maximum B delay period is calculated beginning on July 9, 2006, the day after three years after the application was filed, and ending on September 15,

2009, the date of issuance of the patent, and is 1165 days. As stated in 35 U.S.C. 154(b)(1)(B)(ii), B delay does not include "any time consumed by appellate review by the Board of Patent Appeals and Interferences." The period of B delay does not include the 986 day period beginning on July 9, 2006, the date the Notice of Appeal was filed, and ending on March 20, 2009, the date the Board of Patent Appeals and Interferences issued a decision reversing the examiner. Excluding the 986 days consumed by appellate review results in a period of B delay of 179 days (1165 - 986).

Although the 986 days consumed by appellate review that overlaps with the period of B delay is not part of the period of B delay, the total period of successful appellate review does constitute delay under 35 U.S.C. 154(b)(1)(C) ("C delay"). In other words, the successful appellate period of 1325 days is counted against the Office as a separate adjustment pursuant to 37 CFR 1.702(e) as C delay.

The patent term adjustment is 1396 days, which is the sum of 0 days of A delay and 179 days of B delay and 1325 days of C delay reduced by 108 days of patentees' delay.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

No fee will be charged in connection with this matter because the Office should have addressed patentees' Request for Recalculation of Patent Term Adjustment in View of Wyeth, filed on March 19, 2010 (certificate of mailing date March 15, 2010).

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating

that the term of the above-identified patent is extended or adjusted by **one thousand three hundred ninety-six (1396)** days.

Telephone inquiries should be directed to the undersigned at (571) 272-3230.

A handwritten signature in cursive script, reading "Shirene Willis Brantley".

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,588,212 B2

DATED : September 15, 2009

DRAFT

INVENTOR(S) : Moe et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 1217 days

Delete the phrase "by 1217 days" and insert – by 1396 days--